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Kunio Goto

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EXAMINER

STOUFFER, KELLY M

ART UNIT

PAPER NUMBER

1792

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 2 May 2008 have been fully considered but they are not persuasive. The applicant argues that due to the limitations in the current amendment claim 1 is now commensurate in scope with data (as cited in Tables 1-5) showing unexpected results for the applicants' two-step heating process. However, in Tables 1-5 the examples are much more specific than the language present in the claims. For example, on page 19 of the instant specification, only a specific size of pin surface and box surface of a threaded joint for steel pipes, with specific steel compositions as shown in Table 1, were used in the experiments to show unexpected results. The applicant has not shown that all sizes of pin surface and box surface with all compositions of steel, as the claim currently encompasses, produce the same unexpected results as is claimed. There are specific solvents used in the experiments on page 19, ethanol/toluene in a 50/50 composition for some resins, etc. that are not reflected in the claim, rather the claim encompasses the use of all solvents, where the applicant has shown unexpected results for only certain solvent and resin mixtures. It is also noted that in the results of Table 3, a preheated surface temperature is required, which may or may not affect the unexpected results, and which the claim does not require. The claim language encompasses having no preheating step which may not lead to the results given in Table 3. Further, unexpected results in Table 3 are shown for specific steel types, specific surface treatments, and heating temperatures/times and not a combination of broader Markush groups with temperature and heating time

ranges. For example, unexpected results are shown for steel type A preheated to 60 degrees Celcius with polyamide and molybdenum disulfide and a first heating of 100 degrees for 30 minutes and a second heating of 260 degrees of 30 minutes according to Table 3. Unexpected results are not shown for even the same steel type or lubricating/epoxy mixture at the entire range of claimed temperatures. Unexpected results are not shown for all of the resin and lubricating powder mixtures the claim encompasses. It is noted by the examiner that these examples are for illustration purposes only, and to make the claim commensurate in scope with the data careful review of the data in the instant specification should occur.

Therefore, for at least the above reasons, the amendments do not place the condition for allowance and do not simplify any issues for appeal. The amendments will not be entered after-final and the rejections of the previous office action are maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY STOUFFER whose telephone number is (571)272-2668. The examiner can normally be reached on Monday - Thursday 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1792

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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